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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,364	10/23/2000	Alexei Khomutov	933-160P	2717
2292	7590	04/22/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			WHITE, EVERETT NMN	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/623,364	Applicant(s) KHOMUTOV ET AL.	
	Examiner EVERETT WHITE	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11 and 15 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 7, 12 and 14 is/are allowed.
- 6) ☒ Claim(s) 4, 5, 17 and 19 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 13, 16 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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### **DETAILED ACTION**

1. The amendment filed December 12, 2003 have been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Claim 9 has been canceled;
  - (B) New Claims 17-19 have been added;
  - (C) Claims 1-8 and 10-16 have been amended.
  - (D) Comments regarding Office Action have been provided drawn to
    - (i) restriction requirement, which has been maintained in part;
    - (ii) 112, 2<sup>nd</sup> paragraph rejection, which has been withdrawn;
    - (iii) 102(b) rejection, which has been withdrawn.
2. Claims 1-8 and 10-19 are pending in the case.
3. The text of those sections of title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Final Withdrawn***

4. The finality of the rejection of the last Office action has been withdrawn for the reasons disclosed below.

### ***Answer To Arguments With Traverse***

5. Applicant's election with traverse of Group I, Claims 1-7 and 12-14 in their response filed December 12, 2003 is acknowledged. The traversal is on the ground(s) that Groups I and III should be reunited at the very least according to the guidelines promulgated in PCT Administrative Instructions Annex B, Part 2, Examples Concerning "Unity of Invention", which Applicants argue that the compound of Group I differs from the compound of Group II by having different substituents on the common structure. Applicants argue that when claims differ in this manner, unity of invention exists where there is a common structure and the different substituents in the Markush group do not change the utility of the claimed compound. Applicants also argue for the rejoining of Group II with Group I on the grounds that when a claim is directed to a compound and another claim is directed to making that claimed compound, unity of invention exists between the two claims. Upon reconsideration, Claims 8 and 16 will be rejoined since

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allowable subject matter is indicated. However, Claims 10, 11 and 15 will not be rejoined since these claims are directed to an oxime (Claim 10) and nucleotide or nucleoside pyrimidines or purines (Claims 11 and 15), which are different inventions from the instantly claimed aminooxy-cyclodextrin and method of preparation thereof.

The requirement is still deemed proper and is therefore made FINAL.

***Reply To Final Must Include Cancellation***

6. This application contains Claims 10, 11 and 15 are drawn to an invention nonelected with traverse in Paper No. 12. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Improper Multiple Dependent Claims***

7. Claims 8 and 16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4, 5, 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 4, line 3, the term "bounds" should be changed to - - bonds - -.

In Claim 4, line 10 and Claim 17, line 10, the SO<sub>2</sub>- group should be changed to "-SO<sub>2</sub>-".

In Claim 5, line 3 and Claim 19, line 4, the -OP(O)(OH) group should be changed to "-OP(O)(OH)O-".

In Claim 17, line 10, the -C(O)NH group should be changed to "-C(O)NH-".

In Claim 8, line 19, the term "epoxyor" should be changed to - - epoxy or - -.

***Allowable Subject Matter***

10. Claims 1-3, 7, 12, 14 and 17-19 are allowed.

11. The following is a statement of reasons for the indication of allowable subject matter: The reason for indicating allowable subject matter is that the prior art of record does not teach or fairly suggest an aminooxy-cyclodextrin of the formula 1 set forth in instant Claim 1 and aminooxy protected derivatives thereof. Upon reconsideration, it was agreed that the Varaprasad et al reference does not set forth an aminooxy protected derivative of an aminooxy-cyclodextrin compound.

12. Claims 6, 13 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 4, 5, 17 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Summary***

14. Claims 1-3, 7, 12 and 14 are allowed; Claims 4, 5, 17 and 19 are rejected; Claims 6, 8, 13, 16 and 18 are objected to; Claims 10, 11 and 15 are withdrawn from consideration as being directed to non-elected inventions.

***Examiner's Telephone Number, Fax Number, and Other Information***

15. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (571) 272-0660. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reach on (571) 272-0661. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
E.White

  
James O. Wilson  
Supervisory Primary Examiner  
**Technology Center 1600**